

REMARKS/ARGUMENTS

Claims 1 – 15 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner objected to the abstract due to informalities; rejected claims 4 – 6 under 35 U.S.C. §112, second paragraph for being indefinite; and rejected claims 1 – 11 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,113,819 to Murakawa et al. (hereinafter referred to as “the Murakawa et al. ‘819 patent”).

By this Response and Amendment, claims 9 and 10 have been amended to be independent method claims, the preamble of claim 11 has been amended to recite method language, claims 12 – 15 are newly added, the Abstract has been amended, claims 4 – 6 have been amended to correct informalities; and the prior art rejections have been traversed. It is respectfully submitted that these amendments introduce no new matter to this application within the meaning of 35 U.S.C. §132.

Objection to the Abstract

The Examiner objected to the abstract due to informalities. Specifically, the Examiner objected to the recitation of terms “said” and “means” and to the phrase “in a preferred embodiment.”

Response

By this Response and Amendment, the terms and phrase objected to by the Examiner have been removed from the Abstract thereby rendering the objection thereto moot. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the objection to the Abstract.

Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 4 – 6 under 35 U.S.C. §112, second paragraph for being indefinite. Specifically, the Examiner noted that the phrase “in particular” in claims 4 – 6 renders the claim indefinite; the phrase “an engine compartment” in claim 9 is unclear as to whether it is the same engine compartment as claim 1; and the preamble of claims 9 – 11 is inconsistent with the preamble of claims 1 – 8.

Response

By this Response and Amendment, claims 4 – 6 have been amended to remove the phrase “in particular” and claims 12 – 15 have been newly added to recite the cancelled matter of claims 4 – 6. Also, claims 9 and 10 have been amended to be independent method claims and the preamble to claims 9 – 11 has been amended to be in method claim form. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections to claims 4 – 6 and 9 – 11.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 1 – 11 as being anticipated by the Murakawa et al. ‘819 patent.

Response

By this Response and Amendment, Applicant respectfully traverses the Examiner’s rejection since the prior art reference does not disclose, teach or suggest all of the features of the presently claimed invention. For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art

reference. *Impax Laboratories Aventis v. Pharmaceuticals*, 468 F.3d 1366, 1381 (Fed. Cir. 2006).

Independent claim 1 recites an “[e]ngine compartment partitioning layer (7) for use in an engine compartment (1), wherein said partitioning layer (7) partitions the engine compartment (1) and forms at least one acoustically effective cavity (8) within the closed engine compartment (1).”

The Murakawa et al. ‘819 patent discloses a cooling system for a vertical, liquid cooled engine. However, the Murakawa et al. ‘819 patent does not disclose teach or suggest all of the features of the presently claimed invention.

Applicant submits that the Examiner has not provided enough evidence in support of the rejection of the presently claimed invention and instead seems to be asserting Official Notice of the disclosure, teaching or suggestion of the presently claimed invention in the cited prior art. If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

In the Office Action, the Examiner cites only three citations in the prior art as being analogous to eleven claims of the present application. The Examiner cites figure 2 of the Murakawa et al. ‘819 patent (without identification of specific features therein) as anticipating claim 1. However, figure 2 is disclosed as showing “a side view of the engine cooling system of [a] lawn tractor.” Applicant fails to see where the presently claimed invention is disclosed, taught or suggest in Figure 2 of the Murakawa et al. ‘819 patent.

The Examiner also cites elements 34 (a front air guide cover) and 35 (sound absorbing

material) as being analogous to the invention recited in claim 2 of the present application.

Notwithstanding whether the rejection is accurate, the Examiner hasn't shown how independent claim 1, which claim 2 depends from, is anticipated by the cited prior art. Further, with respect to the other dependent claims, the Examiner makes no prior citations whatsoever; rather, the Examiner makes naked assertions that the presently claimed invention is disclosed in the cited prior art.

Applicant submits that this rejection is improper and requests that the Examiner state with more particularity where in the prior art the presently claimed invention is disclosed, taught or suggested. Otherwise, Applicant respectfully requests that the Examiner reconsider and withdraw the prior art rejections.

MISCELLANEOUS

Claims 12 – 15 are asserted to be patentable over the cited prior art for at least the same reasons as independent claim 1 from which they ultimately depend. Specifically, claim 1 has not been shown to be anticipated by the cited prior art; therefore, claims 12 – 15 are asserted to be patentable by virtue of the patentability of independent claim 1.

CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

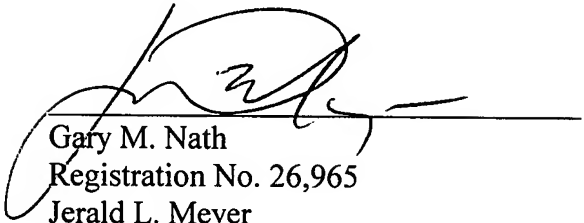
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Respectfully submitted,

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